

REMARKS

Claims 1-24 are pending in this application. Claims 1, 2, 5, 6, 10-15, 17, 19-22 and 24 are rejected. Claims 3, 4, 7-9, 16, 18 and 23 are objected to. Claims 1, 17, 21 and 22 are amended. No new matter has been added. Reconsideration of all pending claims is requested in light of the following remarks.

Applicants amended the independent claims to more positively recite the claim limitations. For example, in independent claim 1 the previously recited "wherein a fax number designating the fax recipient is not contained in the e-mail" was changed to "wherein a fax number designating the fax recipient is obtained independently of the e-mail", and similar amendments were made to claims 17, 21 and 22. Applicants assert their amendments did not result in a change of claim scope.

Claim Rejections – 35 USC § 102

Rossmann: Claims 1, 2, 10-15, 17, 21 and 22

Claims 1, 2, 10-15, 17, 21 and 22 are rejected under 35 USC 102(b) as being anticipated by U.S. Pat. No. 5,809,415 to Rossmann ("Rossmann").

In general, applicants invention is directed towards an email to fax conversion that does not recover a fax number from the email but from another source. Disclosed embodiments involve fax recipients who sign up with a service provider to receive email to fax conversion by designating a fax number that the service provider may then associate with an email and subsequently send email to the fax number. This differs from the cited reference(s) in that the fax number is not extracted from the email itself. The following arguments deal more particularly with the scope of the invention in the pending claims, but in essence involve this distinction.

Claim 1 calls for, in part, at least one fax modem device for transmitting the fax document to the fax recipient through a public switching network, "wherein a fax number designating the fax recipient is obtained independently of the e-mail." In particular, this can be accomplished as disclosed further in the specification without the sender of an e-mail message even being aware the email message is being sent to a fax machine and therefore the sender does not have a need to include the fax number of the intended recipient in the e-mail message.

Rossmann discloses a user selecting a fax key [col. 15, lines 5] and additionally a facsimile machine telephone number [col. 15, lines 27-43] which then appends this facsimile machine telephone number to a resource locator and the fax gateway then uses this

information sent from the user to direct the communication to the facsimile machine at the designated facsimile machine number. Since the fax gateway in Rossmann does not disclose a fax number... is obtained independently of the e-mail", Rossmann does not anticipate claim 1, or similar limitations in claims 17, 21 and 22, as well as their corresponding dependent claims.

Claim Rejections – 35 USC § 103

Rossmann in view of Antoginini: Claims 5, 6, 19, 20 and 24

Claims 5, 6, 19, 20 and 24 are rejected under 35 USC 103(a) as being unpatentable over Rossmann in view of U.S. Publication No. 2004/0218226 to Antoginini ("Antoginini").

In essence, Antoginini does not cure the deficiencies of Rossmann for the base independent claims, and therefore dependent claims 5, 6, 19, 20 and 24, because Antoginini involves sending *from* a fax machine *to* an email recipient, and therefore does not cure the deficiencies of Rossmann regarding conversion *from* email *to* fax message without the email containing the fax number for the fax message to be sent to.

Independent claims 1, 17, 21 and 22, and therefore dependent claims 5, 6, 19, 20 and 24, contain similar limitations requiring in part, a fax modem device for transmitting a fax document to a fax recipient through a public switching network, "wherein a fax number designating the fax recipient is obtained independently of the e-mail."

Antoginini discusses a method and system for sending electronic messages from a fax machine to and e-mail recipient. Antoginini does not discuss converting an e-mail message to a fax message to send to a fax recipient wherein a fax number designating the fax recipient is obtained independently of the e-mail and therefore does not cure the deficiencies of Rossmann. Claims 5, 6, 19, 20 and 24 are therefore patentably distinguishable over Rossmann even in view of Antoginini.

Allowable Subject Matter

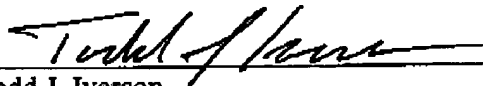
Claims 3, 4, 7-9, 16, 18 and 23 are objected to as being dependent upon a rejected base claim. Applicants note the Examiner's comments regarding allowability of the claims if rewritten in independent form and ask that they be held in abeyance to allow reconsideration of the other rejected claims.

CONCLUSION

For the foregoing reasons, reconsideration and allowance of claims 1-24 of the application as amended is solicited. The Examiner is encouraged to telephone the undersigned at (503) 222-3613 if it appears that an interview would be helpful in advancing the case.

Respectfully submitted,

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Signed:


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